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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,880	12/03/2003	Robert T. Streeter	26333.885	5394

23409 7590 12/18/2006  
MICHAEL BEST & FRIEDRICH, LLP  
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EXAMINER

KIM, CHONG HWA

ART UNIT PAPER NUMBER

2167

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/726,880

Applicant(s)

STREETER ET AL.

Examiner

Chong H. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 13-28 and 33-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/4/05; 4/15/05</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Species I in the reply filed on Nov 2, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The argument regarding the generic claims is noted and agrees, but cannot be considered to be the basis for the traversal of the restriction requirement.
2. Claims 13-28 and 33-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Nov 2, 2006.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Edison, U.S. Patent 1,013,869.

Edison shows, in Figs. 1 and 2, a lubricant circulation system for a shaft that rotates in a bearing, the system comprising an oil ring 7 for drawing lubricant from a lubricant source *a* and delivering the lubricant to a clearance defined between the shaft 8 and the bearing 3, and a

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conduit 17 connected to the clearance for receiving lubricant from the clearance and delivering the lubricant back to the lubricant source; further comprising an axially extending slot 15 formed in the bearing for collecting a portion of the lubricant drawn from the lubricant source; further comprising a radially extending port 16 formed through the bearing and connecting the clearance and the conduit; wherein the lubricant in the clearance is transferred to the conduit by the pressure differential between the clearance and the conduit; wherein the conduit delivers the lubricant from the clearance to a lower portion of the lubricant source; wherein a portion of the lubricant drawn from the lubricant source follows a closed-loop circulation path; wherein the closed-loop circulation path is defined from the lubricant source, to the oil ring, through the clearance, through the conduit, and back to the lubricant source; and wherein the lubricant source is an oil sump.

5. Claims 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Edison.

Edison shows, in Figs. 1 and 2, a lubricant circulation method for a rotary machine, the method comprising: circulating lubricant drawn from a lubricant source a through a bearing 3 to a conduit 17 utilizing pressure generated within the bearing; circulating lubricant through the conduit and back to the lubricant source to complete circulation of the lubricant through a closed-loop circulation path; wherein the bearing surrounds a shaft 8; providing an oil ring 7 extending around the shaft and in a slot 10 in the bearing and extending in the first lubrication source so that rotation of the shaft and the oil ring draws lubricant from the lubricant source to the bearing; wherein lubricant circulated from the lubricant source collects in a lubricant feed slot 16 formed in the bearing before circulating to the conduit.

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lubricant circulation system using oil ring.

Heshmat, U.S. Patent 4,531,845

Rivard, U.S. Patent 5,630,481

Gardner, U.S. Patent 5,601,155

Erickson, U.S. Patent 4,591,024

Mair, U.S. Patent 3,826,338

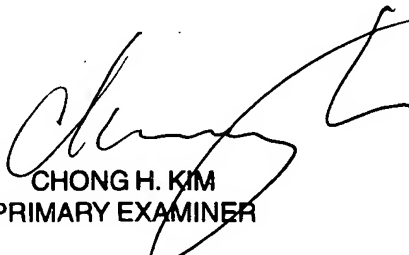
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (571) 272-7108. The examiner can normally be reached on Monday - Friday, 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

chk  
December 12, 2006



CHONG H. KIM  
PRIMARY EXAMINER